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10/065,120	09/18/2002	Scott C. Harris	GPSPrivC1	8217

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EXAMINER	
ISSING, GREGORY C	
ART UNIT	**PAPER NUMBER**
3662	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/065,120	HARRIS, SCOTT C.	
	Examiner	Art Unit	
	Gregory C. Issing	3662	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on 4/23/07.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1,2,4-7,9-13,15,17-20,23-27,51 and 52 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1, 2, 4-7, 9-13, 15, 17-20, 23-27, 51 and 52 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. In view of the new amendments and broadening of the claims, new rejections are set forth below.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 2, 9-13, 15, 17-20, 23-27 and 51-52 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a "security part" using an override control button or an attachable RF blocking shield positioned in proximity to the positioning antenna to prevent the determination of position during an enhanced security mode, does not reasonably provide enablement for (1) a testing part, that tests the security part", (2) "a position privacy control that enhances the privacy of the portable communicator", (3) "a testing part, operating to test said privacy enhancing", (4) "a testing part that tests a privacy of said communicating electronics", and (5) "a testing part that tests an operation of said position reporting control." The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. The specification provides two embodiments for privacy control: first, via a manual override control button that prevents the automatic position sensing device from automatically determining position, and second, via a wrap-around plate that prevents the position sensing device antenna from receiving a signal. In each of these embodiments, the "security part" is a mechanical override control button or an attachable shield. The testing module operates during an enhanced mode defined by when the override button is pressed or the shield is attached to the device. All of the rejected claims are broader in scope

than that which is described by the specification and thus, the scope of the claims are not commensurate in scope with the disclosed specification.

4. Claims 1, 2, 9-13, 15, 17-20, 23-27 and 51-52 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification lacks any description of a "testing part that tests said security part"; the specification merely provides a testing module that tests the degree of privacy of a position detection by transmitting a request to the electronic device and receiving a reply and testing to see if a position is provided in the reply, thus claim 1 is rejected. Claim 9 is considered new matter since the testing of a communicator is not disclosed in the specification as originally filed. Additionally, claim 10 is considered new matter since the specification, as originally field, does not include testing the communication electronics. The specification does not provide a description of testing the position reporting communication but rather tests the position detection (see paragraphs [0014] and [0015]).

5. Claim 52 is new matter and is required to be cancelled. The specification does not disclose a "reporting device" specifically separate from "communicating electronics. Moreover, the specification, as originally filed, does not provide for any request for privacy that "prevent(s) said reporting device from reporting any information indicative of the determined position in any mode of operation of said portable telephone."

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 2, 9, 10-13, 15, 17-19, 24-27, and 52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The language in claim 1, "a testing part, that tests said security part" is indefinite since the "security part" as provided by the specification is limited to an override control button or an attachable shield. It is not understood how either one of these two mechanical devices is tested or what the "testing part" comprises in connection with the override control button or the shield. Thus, the "testing part" fails to clearly and distinctly define the subject matter which the applicant regards as the invention.

In claim 9, it is unclear what is defined by "a position privacy control that enhances the privacy of the portable communicator" in relation to the disclosed subject matter since the privacy is provided via the denial of the position detection capability which is not set forth in the claim. It is unclear what the metes and bounds are of "a position privacy control that enhances the privacy of the portable communicator". The metes and bounds of "a testing part" are undefined in the claim. The language "said privacy enhancing" lacks a proper antecedent basis as well as fails to clearly define what "privacy enhancing" is.

Claim 10 is indefinite since it is unclear what the scope of the "testing part" is since the specification is silent as to the testing the privacy of the communications electronics but rather is directed to testing the position detection. The scope of " testing part that tests a privacy of said communicating electronics" is indefinite and fails to clearly and distinctly define the subject matter.

In claim 24, the language "after said first specified actuation" lacks a proper antecedent basis and is indefinite.

In claim 26, the language "a state of said first specified actuation" is indefinite and lacks a proper antecedent basis.

Claim 52 lacks a proper antecedent basis for "said telephone" or "said telephone electronics". The claim fails to clearly and distinctly define the subject matter particularly since it is unclear what the "reporting device " is and if and how it is different from the "communicating electronics".

It is noted that originally the claims were restricted between the integrated communication/position device and a testing module for an electronic device. The applicant has now switched all claims to be directed to the inclusion of the testing module, which was a non-elected invention.

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 1, 2, 4-7, 9, 10, 13, 17-20, 23-27, and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zellner et al (6,675,017) in view of Simms et al (5,334,974) and Mohan (6,121,922).

Zellner et al disclose a location blocking service for a wireless network. Zellner et al teach a wireless handheld device 200, meeting the scope of the claimed "communication device" of claim 1, the claimed "cellular telephone," of claim 4, the claimed "electronic device," of claims 9 and 20, and the claimed "portable communication device," of claim 10, operating over a wireless network 210, (1) wherein the handheld device is exemplified as a cellular telephone

(2:5-15), (2) wherein the wireless handheld device includes a position detection module 220 preferably in the form of a GPS receiver (5:60-62), such that position may be reported to a remote location for emergency purposes or for services, (3) wherein the device includes a user interface 202, and (4) wherein the handheld device includes a location block device processor 204. The location block device processor 204 reads on the claimed "security part" because in the embodiment of the location being determined in the handheld device, (1) it is actuated by the user to enhance privacy (2:51-60 and 3:14-38), (2) it is manually actuated in response to the user using the user interface (6:1-15, 6:23-29 and 7:54-60), and (3) it can either alternatively (3a) disable a location system and substitute dummy information, which dummy information could comprise substituting no information at all, or (3b) receive location information and substitute dummy information (6:18-30) such that wireless communication from the handheld device to the network continues to operate, thus providing evidence of the continued operation of the wireless handheld device while enhancing privacy by disabling the reporting of user position.

Zellner et al differ from the claimed subject matter since a "testing part" is not specified.

Simms et al teach a portable electronic device 30 integrating a position detection module 70 and a communication module 60 that includes a set of user-controlled buttons 33 for activating certain functions as well as indicator lights 35 which provide an indication of which push buttons are activated. One of the buttons is taught to be a "Test" button that initiates a self-test of the device 30, wherein the self-test diagram is shown in Figure 6B and operates to test the telephone operation as well as the position receiver operation. Thus, Simms et al suggest to one of ordinary skill in the art the use of push buttons to activate certain functions on a portable communication/position detection device as well as optical indicators to provide an indication of

which functions are activated as well as suggest the use of a self-test to provide information with regard to the proper operation of the device.

Mohan teach that it is known in the art of electronic communication devices integrated with position detection/reporting modules, e.g. GPS receivers, to test the operation of the communication device by transmitting a communication message to a wireless network, receiving a reply message, and comparing the transmitted message to the replied message to test operation of the device (5:67-6:15). Thus, Mohan suggest to one of ordinary skill in the art to test the validity of operation of a communicated message incorporating position information. .

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Zellner et al by incorporating testing functions of the electronic device in view of the teachings of Simms et al wherein the user may test the functionality of a privacy function which incorporates both the communication operation and position locator operation of Zellner et al and thereby provide the user with an indication of the proper functionality of certain aspects of the device. Moreover, it would have been obvious to one of ordinary skill in the art to further test the functionality in the manner of comparing a transmitted message with a replied message in view of the teachings of Mohan. It would have been obvious to test the privacy function during the privacy mode by observing if the replied message from the monitoring network station contained position information of the electronic device.

The combination of prior art teach a GPS receiver and thus a satellite positioning system receiver as well as the use of a network based service in view of the use of the wireless network used in the transmission and reply of the message. Zellner et al teach the prevention of position determination by the position detection device as well as the prevention of position reporting, see

above. The combination of references suggest the use of an optical indicator to indicate the operational status of various components of the device.

Applicant argues that the claims are allowed in view of the incorporation of the "testing limitation" of claim 4. The applicant's arguments are not convincing since (1) the claims do not reflect the claim limitations of previously allowed claim 4 as they simply set forth a "testing part" that is much broader in scope than the claimed method steps involved in claim 4, and (2) upon further review and consideration, the "testing part" limitation is found not to be patentable in view of the newly cited art. The teachings of Simms et al provide the artisan in the field of portable electronic devices combining communication and position detection with the suggestion to test the operation of the electronic device in both the operation of the communication and the position elements of the device and to provide an indication to the user in response thereto. The teachings of Mohan provide the artisan in the field of portable electronic devices combining communication and position detection with the suggestion to test the operation of the electronic device by transmitting a message that may include a position to a monitor network station, receive a reply from the network station, and compare the transmitted and replied messages to see if the aspects of the system are functioning properly. Operation of the testing function during the privacy mode would obviously be a desired function to be tested

10. Claims 11, 12, 15 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zellner et al in view of Simms et al and Mohan as applied to claim 10 above, and further in view of either one of Roeder (5,491,745) or Altidor et al (5,894,276).

Zellner et al in view of Simms et al and Mohan teach the subject matter substantially as claimed as set forth above but do not specifically show a single button as the override control to

be pressed to activate the request for privacy enhancement. Each of Roeder and Altidor et al teach the conventionality at the time the invention was made to utilize one-touch keying to perform functions on mobile electronic devices. Roeder teaches the conventionality of one-touch recall and dialing in a cellular phone obviating the need for multiple-step key activation (1:56-2:8). Altidor et al teach the conventionality of a customizable or programmable function button that can be associated with an important or frequently used function since it is known to be desirable to minimize the necessary user interaction to achieve a particular function (1:12-42).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Zellner et al in view of Simms et al and Mohan to manually activate/deactivate privacy control via an user interface comprising a single key input in view of the teaching of Zellner et al (1) to activate such function via a menu selection, key sequence or graphical user interface and (2) the teaching that the location block processor and the user interface could be a single component (3:32-37), and further in view of the teachings of either one of Roeder or Altidor et al who are exemplary of the fact that one-touch shortcut keys were conventional in wireless communication devices at the time of the invention for the reasons set forth above.

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

12. Claims 1, 2, 9, 10, 13, 17, 18, 20, 23, 24, and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Moles et al (6,505,048).

13. Moles et al discloses a method and apparatus for enabling location privacy features in a portable electronic device 112 (Figure 2) comprising a communication device and a position detection module wherein the communication device may be a cellular telephone 210/220/215/225/230 and the position detection device may be a GPS receiver 260. Additionally, Moles et al disclose the use of a location privacy flag, that meets the scope of the claimed "security part," "position privacy control," and "position reporting control" since it produces a signal that prevents the communication device from reporting the actual position of the communication device by sending null data or altered substitute location data. Moreover, the privacy flag may be selectively set by the user via the device user interface. An override of the privacy location function is performed by code authorization unit 276. Lastly, there is included a privacy flag record 277 that stores a history of the time and date of occurrence of location privacy flag being enabled or disabled for access by the user on the user display 255 or to another output via the I/O interface 245. The accessing and viewing of the history operates to "test" the privacy enhancing by showing when the location privacy is enabled and disabled.

14. Claims 4-7, 19, 26-27 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moles in view of Simms et al and Mohan.

15. Moles et al teach the subject matter substantially as shown as set forth above but fail to show the use of "testing" as envisioned by the applicant.

Simms et al teach a portable electronic device 30 integrating a position detection module 70 and a communication module 60 that includes a set of user-controlled buttons 33 for activating certain functions as well as indicator lights 35 which provide an indication of which push buttons are activated. One of the buttons is taught to be a "Test" button that initiates a self-test of the device 30, wherein the self-test diagram is shown in Figure 6B and operates to test the telephone operation as well as the position receiver operation. Thus, Simms et al suggest to one of ordinary skill in the art the use of push buttons to activate certain functions on a portable communication/position detection device as well as optical indicators to provide an indication of which functions are activated as well as suggest the use of a self-test to provide information with regard to the proper operation of the device.

Mohan teach that it is known in the art of electronic communication devices integrated with position detection/reporting modules, e.g. GPS receivers, to test the operation of the communication device by transmitting a communication message to a wireless network, receiving a reply message, and comparing the transmitted message to the replied message to test operation of the device (5:67-6:15). Thus, Mohan suggest to one of ordinary skill in the art to test the validity of operation of a communicated message incorporating position information. .

16. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Moles et al by incorporating testing functions of the electronic

device in view of the teachings of Simms et al wherein the user may test the functionality of the privacy function which incorporates both the communication operation and position locator operation of Moles et al and thereby provide the user with an indication of the proper functionality of certain functions of the device. Moreover, it would have been obvious to one of ordinary skill in the art to further test the functionality in the manner of comparing a transmitted message with a replied message in view of the teachings of Mohan. It would have been obvious to test the privacy function during the privacy mode by observing if the replied message from the monitoring network station contained position information of the electronic device.

17. Claims 11, 12, 15 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moles et al in view of Simms et al and Mohan as applied to claim 10 above, and further in view of either one of Roeder (5,491,745) or Altidor et al (5,894,276).

Moles et al in view of Simms et al and Mohan teach the subject matter substantially as claimed as set forth above but do not specifically show a single button as the override control to be pressed to activate the request for privacy enhancement. Each of Roeder and Altidor et al teach the conventionality at the time the invention was made to utilize one-touch keying to perform functions on mobile electronic devices. Roeder teaches the conventionality of one-touch recall and dialing in a cellular phone obviating the need for multiple-step key activation (1:56-2:8). Altidor et al teach the conventionality of a customizable or programmable function button that can be associated with an important or frequently used function since it is known to be desirable to minimize the necessary user interaction to achieve a particular function (1:12-42). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Moles et al in view of Simms et al and Mohan to manually activate/deactivate

privacy control via an user interface comprising a single key input in view of the teaching of Moles et al (1) to activate such function via a menu selection, key sequence or graphical user interface and (2) the teaching that the location block processor and the user interface could be a single component (3:32-37), and further in view of the teachings of either one of Roeder or Altidor et al who are exemplary of the fact that one-touch shortcut keys were conventional in wireless communication devices at the time of the invention for the reasons set forth above.

18. The rejection regarding Lemelson et al is withdrawn because it is deemed to be superfluous to the rejections set forth above.

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Each of the following patents disclose an electronic communication device wherein user privacy is enhanced by the use of a security part that inhibits reporting of location: Raith (6,687,504), see e.g., 2:36-3:35, and, Havinis et al (6,311,069), see e.g. Figure 6.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory C. Issing whose telephone number is (571)-272-6973. The examiner can normally be reached on Monday - Thursday 6:00 AM- 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Tarcza can be reached on (571)-272-6979. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gregory C. Issing
Primary Examiner
Art Unit 3662

gci